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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,457	08/14/2000	Eric Boyd	18567-0012	9536
20872	7590	08/29/2006	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/638,457

Applicant(s)

BOYD ET AL.

Examiner

Raquel Alvarez

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**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 24, 25, 38, 40-42, 46, 50-55, 58, 59 and 75-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 24, 25, 38, 40-42, 46, 50-55, 58 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 75-79 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to communication filed on 6/23/2006.
2. Claims 1-8, 24-25, 38, 40-42, 46, 50-55 and 58-59 are presented for examination.

### **Election/Restrictions**

3. Newly submitted claim 76 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: how the merchant is obtained the points.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 76 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites on line 9 "accept items for auction from the users" and on lines 9-10 "accept bids from the users on the items". It is not clear if the users in this two instances are the same users or different users. For examination purpose they will be treated as being different users.

Correction is required.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 24-25, 38, 40-42, 46, 50-55, 58-59 and 75, 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copple et al. (6,178,408 hereinafter Copple) in view of Applicant's background of the invention.

With respect to claims 1, 38, 50, 40, 46, 76, Copple teaches an offline-Online points system operable to provide a user with an interface to submit a code obtainable from user from an item (col. 3, lines 64- to col. 4, lines 34); operable to maintain a set of valid codes and to determine whether the code submitted by the user is a valid code and if valid then to credit the user balance with other points credited for point actionable activities (col. 4, lines 5-26) redeemable for value including for an item which the user won in an auction (see Figure 4a); operable to track the point balance in an account with an account database having a plurality of accounts configurable for transferring points therebetween (Figure 2a, 210); tracking a point balance of the user in an account of an account database having a plurality of accounts to transfer points among the plurality of accounts and to characterize each point of the point balance as one of purchase (col. 4, lines 8-26)

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With respect to the actionable activities including an advertisement and registering with a website. Applicant admitted on page 2, lines 15-19 that it is old and well known for one of the activities for earning points is **clicking on advertisements, filling out registrations and surveys....**Users accumulate points into an account from which they can redeem their points for certain goods or services. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included for one of the actionable activities to include an advertisement and registering with a website because such a modification would allow customers to earn points for their time without having the need to make a purchase.

With respect to providing respective credit lines to users that are heavily active in order to supplement the point balance of their respective account with credit points. Official notice is taken that it is old and well known to provide credit lines to users that are heavily active in paying their debts on time because such users are low credit risk. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing respective credit lines to users that are heavily active in order to supplement the point balance of their respective account with credit points because such a modification would allow the system to advanced points to users that are likely to repay the borrow points.

With respect to the newly added feature of accepting items for auctions from the users. The Examiner wants to point out that the promoters are the one posting the items for auctions in the system, the promoters are different retail goods or services and therefore they are users of the Copple's system.

With respect to claims 2-4, Copple further discloses maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code (col. 3, lines 64 to col. 4, lines 34).

With respect to claims 5-8, Copple discloses a system for an awards points account and therefore it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention was made to identify the coupon used in Copple using any numbers of letters, numbers and/or characters. One would have been motivated to allow the use of a variable length code on the coupon in order to increase the flexibility of the system to encompass both and large point systems, i.e. a large system with millions of users submitted multiple codes (e.g. 100) each would require identification codes much larger than a system with only 100 users who submit only 5 codes each.

With respect to claim 58, Copple discloses a system for an awards point and further discloses means for generating the code and fixing the code onto an offline medium (such as a product or product packaging)(col. 3, line 64 – col. 4, line 34).

With respect to claims 25, 59, Copple further discloses that the code (coupon) is affixed to the product or product packaging, it is not explicitly disclosed that the product packaging is a bottle cap. However, the inside surface of a bottle cap, the sides of plastic or paper food and beverage containers, the inside surface of candy

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wrappers, etc. are all well known pads of product packaging used to carry and/or conceal game pieces and codes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the code on the inside of a bottle cap of Copple's product. One would have been motivated to print the code on the bottle cap in order to prevent an unauthorized person from removing the code without purchasing the product.

With respect to claim 52, Copple explicitly discloses that point systems are known in which the points can be redeemed for a gift or discount (col. 1, lines 23-27).

With claims 53 and 54, Copple do not explicitly disclose the type of auction. The Examiner notes that the claimed auction types are all well known types of auctions. Furthermore, the type of auction being conducted has no effect whatsoever on the claimed system of accumulating and redeeming incentive points. Thus, little patentable weight is given to the type of auction or how the auction is run. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to know that any method of determining an item to purchase for which the award points would be redeemed could be used, to include any type of auction, since the procedure has no connection to the incentive awards method.

With respect to claims 41, 55, Copple further discloses adding or subtracting points from the account based on the users interaction (point-actionable event) with the

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system; thus, maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code or a winning bid (col. 3, line 64 – col. 4, line 34).

With respect to claims 24, 42 and 51, Copple does not explicitly disclose that the user account would be placed behind a firewall and further protected using encryption. Copple discloses that a user's registration information also includes a "personalized log on password" (col. 5, lines 4-6). While it is not explicitly disclosed that the account data will also be encrypted, encryption is a well known security measure used to protect data especially when it is being transmitted over an unsecured network such as the Internet and, thus, would have been an obvious addition to the security measures disclosed by Copple.

### **Response to Arguments**

7. 101 rejection has been withdrawn.
8. Applicant states that Copple teaches that the items available for auction are provided by a centralized promoters rather than other users of the system. The Examiner wants to point out that although the auctions are provided by a centralized promoters system (as stated by Applicant), the promoters are individual posting the items for auctions in the system, the promoters are different retail goods or services and therefore they are users of the Copple's system. The claims only call for "accepting



items for auction from the users” and like stated above, the claimed limitations is taught by Copple promoters providing the items available for the auction.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. that the item auctioned, which the users may bid on is provided by a business other than the business operating the auction itself) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. Applicant argues that Copple and the background do not teach crediting points to users, accepting items for auction from the users, accepting bids on those items from the users, and subtracting/adding points to accounts of winners/auctioneers of these items. The Examiners wants to point out that in Copple the users are credited with points and these points can be used to bid on an items, the points redeemed or credited are stored in database 410.

11. Claim 76 as amended is restricted by original presentation and therefore the arguments with respect to this claims are moot.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

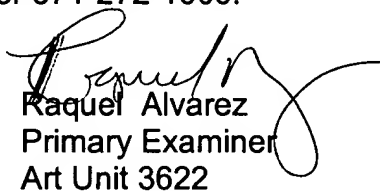
**Point of contact**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
8/22/2006